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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,843	02/15/2001	John T. Hurst	30788-00016	3829
43914 7590 04/01/2008 JOSEPH SWAN, A PROFESSIONAL CORPORATION 1334 PARKVIEW AVENUE, SUITE100 MANHATTAN BEACH, CA 90266				
EXAMINER				
BLAIR, DOUGLAS B				
ART UNIT		PAPER NUMBER		
2142				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/784,843

Applicant(s)

HURST ET AL.

Examiner

DOUGLAS B. BLAIR

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9, 11, 12, 15, 17-19, 21, 23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 11, 12, 15, 17-19, 21, 23 and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Appeal Brief

In view of the Appeal Brief filed on 1/7/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection and objections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing at the conclusion of this office action.

Response to Arguments

Applicant's arguments filed 1/7/2008 have been fully considered but they are not persuasive. Though the applicant's arguments were not considered to be persuasive, a new grounds of rejection was made after a careful review of the subject matter of claim 33.

In response to the applicant's first argument (on page 9 of the Brief) that Nagai does not teach any transmission to a remote location, the Examiner points out that the background of

Nagai makes it clear that the whole purpose of the Nagai invention is for transmitting media files over the internet. If the applicant persists with this argument, the applicant should point out how the background of Nagai differs from the transmission of multimedia data.

In response to the argument that purpose of Nagai is to send only a portion of a document to a user, the Examiner points out that Nagai teaches two embodiments. The applicant seems to be selectively ignoring the embodiment where all of the media files are sent to the destination.

The applicant's arguments against Panabacker miss the point. Panabacker is not relied upon to teach each and every limitation. If it were it would be part of a 102 rejection and not a 103 rejection. Panabacker is only relied upon to show that transmitting some files electronically (via the Internet) and some files through media (such as a CDROM) is an obvious concept. Nagai teaches all of the other elements as mapped. Since Nagai teaches transmissions generically in the background it would be obvious to combine Nagai with basic transmission techniques such as those taught by Panabacker and those claimed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 33 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 33 is rejected as being directed towards an apparatus comprising means that are interpreted as software elements. The applicant's specification does not disclose any hardware for performing the specified functions and the applicant's specification states that the claimed functionality can be implemented entirely of software (See page 19, lines 27-30).

Since the apparatus as claimed only comprises software, claim 33 is treated as software per se. Software per se does not fit into a statutory category of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification provides no support for means plus function limitations since there is no disclosure of what the means for receiving, the means for storing, or the means for at least one of executing or playing comprises.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites the limitation "step (a)" in the final limitation of the claim. There is insufficient antecedent basis for this limitation in the claim. There is a "means (a)" but no "step (a)".

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the apparatus of claims 29-33 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-6, 9, 11-12, 15-16, 19, and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent Number 6,795,092 to Nagai et al. in view of U.S. Patent Application Publication Number 2003/0023970 by Panabaker.

As to claim 1, Nagai teaches a method for use in delivering programming content, said method comprising: (a) dividing programming content into smaller chunks of data, wherein said programming content comprises at least one of (i) a software program or (ii) content for playing on an electronic device (col. 5, lines 34-57, and Figure 4); (b) creating a chunk file for each chunk of data, said chunk file including said chunk of data (multimedia files in Figure 4); (c) generating a manifest file that includes information describing how at least one of execute or play the chunks of data (reproduction control information in Figure 4); and (d) transmitting the chunk files created in step (b) and the manifest file generated in step (c) to a remote location (col. 5, lines 24-33); however Nagai does not explicitly teach wherein at least one of the field transmitted in step (d) is transmitted electronically and at least one of the files transmitted in step (d) is transmitted on a physical storage medium.

Panabaker teaches a method in of distributing programming content which includes a manifest file, in which some files are transmitted electronically and some files are transmitted on a physical medium (paragraph 59).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Nagai regarding a programming content delivery method with the teachings of Panabaker regarding specific delivery method for

programming content because sending a manifest file electronically allows quicker updates of presentation data.

As to claim 5, Panabacker teaches a method wherein the chunk files are distributed across a set of physical storage media, and wherein each of said physical storage media in the set contains the manifest file (paragraph 27).

As to claim 9, Nagai teaches a method wherein the manifest file identifies each chunk of data in the programming content (the reproduction control information in Figure 4).

As to claims 25-26, Nagai teaches the transmission of multimedia files and Panabacker teaches the transmission of television. Official Notice is taken that motion pictures are considered to be part of the data that television comprises.

As to claims 11, it is rejected for the same reasons as claim 1.

As to claim 12, the SMIL specification teaches a method wherein the chunks of data are stored such that each chunk remains separately identifiable (multimedia files in Figure 4).

As to claims 15-16 and 19, they are rejected for the same reasons as claims 5-6 and 9.

As to claims 27-33 are rejected for the same reasons as the preceding claims.

Claims 7-8, 17-18, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,795,092 to Nagai et al. in view of U.S. Patent Application Publication Number 2003/0023970 by Panabaker in further view of RFC 1321 by Rivest.

As to claims 7-8, 17-18, 21, and 23 the Nagai-Panabaker combination makes obvious the subject matter of claims 1, 10-11 and 20; however the Nagai-Panabaker combination does not explicitly teach the use of a message digest.

Rivest teaches the use of a message digest for verifying integrity of data (See executive summary).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Nagai-Panabaker combination regarding the use of chunk files for transmitting data with the teachings of Rivest regarding the use of a message digest because a message digest is a computer networking standard and thus a well known method for verifying the integrity of data received. U.S. Patents 5,765,176, 5,745,574 and 5,692,047 are some examples of publications that illustrate the use of message digests.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/
Patent Examiner, Art Unit 2142

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2142